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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/963,397

09/27/2001

Toshiya Takahashi

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03/03/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

THOMPSON, JAMES A

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/963,397

Applicant(s)

TAKAHASHI ET AL.

Examiner

James A. Thompson

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-9,11-17,19-25 and 27-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: Examiner's Amendment.

DETAILED ACTION

Response to Amendment

1. Applicant's proposed amendments to the claims are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Accordingly, the **proposed amendments to the claims will not be entered.**

Response to Arguments

2. Applicant's arguments filed 01 February 2006 have been fully considered but they are not persuasive.

Applicant argues that it would not have been an obvious engineering design choice to use the specifically recited transmission sequence of claim 3, which depends from claim 1 and that the transmission sequence solves certain problems described in the specification.

Examiner replies that the transmission sequence of claim 3 is still an obvious engineering design choice, as demonstrated from the fact that, in Steele (US Patent 5,884,056), non-scene-changing still pictures are selected in the interval between scene-changing still pictures (column 9, lines 39-45 of Steele). This process can be iterated repeatedly to narrow down the interval (column 9, lines 57-59 of Steele). A natural place for one to select a non-scene-changing picture would be between the two scene-changing still pictures corresponding the largest time interval since such a selection would better narrow down the video, giving fuller information to the user.

Applicant argues that the references only teach transmitting scene-changing and non-scene-changing still pictures in two transmission, not one.

Examiner replies that Applicant is attempting a piecemeal analysis of the reference by simply focusing on Steele. The rejection of claim 1 is based on Steele and Hori (EP 1 024 444 A2). The transmission sequence is taught *by combination*, and not by a single reference, as clearly set forth on page 5 of the previous office action, dated 02 November 2005 and mailed 10 November 2005. Hori teaches that non-scene-changing still pictures are sent *along with* the scene-changing still pictures, as set forth on page 5, lines 1-9 of said previous office action. While it is true that Steele alone teaches that the non-scene-changing still pictures are sent in a second transmission, *by combination* with Hori, Steele and Hori teach sending the scene-changing and non-scene changing still pictures in a single transmission. In Steele, a second transmission is required since the process of sending non-scene-changing still pictures is performed based on a user selection. However, Hori teaches that acquiring and sending the non-scene-changing still pictures along with the scene-changing still pictures is automated and sent as a single transmission. Thus, the *combination* of Hori and Steele fully teaches claim 1.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with W. Todd Baker (Reg. #45,625) on 21 February 2006.

The application has been amended as follows:

- a. In the Abstract, line 20 is **to be deleted**.
- b. In claim 1, line 12, change "units;" to "units,".
- c. In claim 5, line 1, change "comprising;" to "comprising:".
- d. In claim 9, line 12, change "apparatus" to "apparatus,".
- e. In claim 13, line 1, change "comprising;" to "comprising:".
- f. In claim 21, line 1, change "comprising;" to "comprising:".
- g. In claim 25, lines 1-2, change "A computer program product for transmitting still pictures extracted from a picture stream, comprising:" to "A computer-readable medium encoded with a computer program code for transmitting still pictures extracted from a picture stream, wherein said computer program code is executed by a computer, said computer program code comprising:".
- h. In claim 25, line 3, change "the-a" to "a".
- i. In claim 28, lines 1-2, change "The computer program product according to claim 25, further comprising:" to "The

Art Unit: 2625

computer-readable medium according to claim 25, said computer program code further comprising:"

j. In claim 29, line 1-2, change "The computer program product according to claim 25, further comprising;" to "The computer-readable medium according to claim 25, said computer program code further comprising:"

k. In claim 30, lines 1-2, change "The computer program product according to claim 29, further comprising:" to "The computer-readable medium according to claim 29, said computer program code further comprising:"

l. In claim 31, lines 1-2, change "The computer program product according to claim 25, further comprising:" to "The computer-readable medium according to claim 25, said computer program code further comprising:"

m. In claim 32, lines 1-2, change "The computer program product according to claim 25, further comprising:" to "The computer-readable medium according to claim 25, said computer program code further comprising:"

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



24 February 2006

James A. Thompson
Examiner
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